

Remarks

Claims 1-17 are pending in the present application, with claims 18-27 having been withdrawn from consideration by the Examiner as being drawn to non-elected inventions. Note, Applicants request that claim 18 be considered by the Examiner. (See below).

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,874,606 to Huang et al.

Claims under Examination

In the Office Action dated March 7, 2005, the Examiner requested election of either Group I (claims 1-18) or Group II (claims 19-27). Applicant elected to prosecute Group I, with traverse, in a response filed April 7, 2005.

In the Office Action dated June 7, 2005, the Examiner withdrew claims 18-27 from consideration and examined claim 1-17, eventhough claims 1-18 were elected.

Applicant respectfully requests that the Examiner examine claim 18.

Claims Analysis

The Examiner stated that claim 1 was interpreted in light of the preamble because it breathes life into the claim. Applicant respectfully disagrees with the Examiner that the preamble to the method of claim 1 is necessary to breathe life into the claim, because the Examiner has not identified what the Examiner considers the text of the preamble to be.

Claim 1 - 35 U.S.C. § 112, second paragraph

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Contrary to the Examiner's statements, claim 1 does particularly point out and distinctly claim the subject matter that Applicant regards as the invention and the specification provides a clear definition to the phrase "conditions sufficient to produce the coupled aromatic compound" in places other than the Examples section. The phrase "conditions sufficient to produce the coupled aromatic compound" is extensively defined in paragraphs [0085] - [0094] as well as in the Examples section.

Further, a determination of whether the comparative examples in the Examples section are within the prior art or are Applicant's original work is not necessary to understand the meaning of the phrase "conditions sufficient to produce the coupled aromatic compound". Applicant makes no representation that the comparative examples are within the prior art or are Applicant's original work.

Thus, Applicant respectfully traverses the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-17 - 35 U.S.C. § 102(b)

Claims 1-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,874,606 to Huang et al. Contrary to the Examiner's statements, claims 1-17 are not anticipated by Huang.

Claim 1 of the present application recites "[a] method for coupling: an organomagnesium compound of the formula: R^1MgX^1 with an aromatic ether compound of the formula: Ar^1-OR^2 ". (emphasis added). Huang does not disclose coupling an organomagnesium compound with an aromatic ether compound. The only coupling partner with an organomagnesium compound in Huang is an *ortho*-chlorobenzonitrile, which is not an aromatic ether.

Thus, Applicant respectfully traverses the rejection of claims 1-17 under 35 U.S.C. § 102(b) as being anticipated.

Conclusion

With the above amendments and remarks, Applicant believes that all rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. Passage of the instant invention to allowance is earnestly solicited.

Applicants believe that no fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 50-3216.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 841-0300 ext. 159 to discuss any issues.

Respectfully submitted,

Date: Aug. 22, 2005

Samuel B. Rollins
Samuel B. Rollins
Registration No. 52,180

TransTech Pharma, Inc.
4170 Mendenhall Oaks Pkwy
Suite 110
High Point, NC 27265
Phone: (336) 841-0300
Fax: (336) 841-0310